

Appl. No.: 09/540,469  
Amdt. dated 05/25/2005  
Reply to Official Action of February 25, 2005

**REMARKS/ARGUMENTS**

Applicant appreciates the thorough examination of the present application, as evidenced by the first substantive Official Action. A Restriction Requirement dated September 20, 2004 required election between Group I, namely Claims 1-71, and Group II, namely Claims 72-79. In response, Applicant provisionally elected with traverse to prosecute the claims of Group I (Claims 1-71) and expressly reserved the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims. Accordingly, Claims 1-71 are currently pending for examination, and Applicants hereby cancel non-elected Claims 72-79.

The first Official Action rejects all of the pending claims, namely Claims 1-71, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,050,490 to Leichner et al., in view of U.S. Patent No. 5,921,582 to Gusack. As explained below, Applicants respectfully submit that the claimed invention of the present application is patentably distinct from the Leichner and Gusack patents, taken individually or in combination. Accordingly, Applicants respectfully traverse the rejections of the claims as being unpatentable over the combination of the Leichner and Gusack patents. In view of the amendments to the claims and the remarks below, Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application.

The Leichner patent provides a handheld writing device and related data entry system. The system includes a digital electronic clipboard for mounting pages or forms utilized in forms processing applications, such as inventory tracking. The system also includes a stylus with a writing tip at one end, and a bar code scanning mechanism at another end. As such, the stylus can be used to both enter data on the pages or forms, and to scan bar codes appearing on the pages or forms themselves or on a separate item to be associated with the form. In operation, the system detects whether bar code data or stylus position data is being generated and causes a central processing unit (CPU) to responsively process entered data. Alternatively, the system also permits generation of either stylus position data or bar code data at any given time.

The Gusack patent provides an indexing system, record structure and linking method for paper-based and electronic-based informational assemblies. As disclosed, the indexing system

Appl. No.: 09/540,469  
Amtd. dated 05/25/2005  
Reply to Official Action of February 25, 2005

and linking method is provides for an assembly of paper-based informational items ordered by an hierarchy of informational divisions represented by a plurality of tabbed section dividers and tabbed file folders with pre-assigned section indicia printed thereon. Similarly, a plurality of sections include a plurality of form pages and document pages with pre-assigned section and page indicia printed thereon, and the pages include a plurality of tabular design objects printed thereon. The tabular objects include a plurality of records that contain a plurality of data fields for entering informational items thereon, where each record has a pre-assigned indicum printed in another entry field. Accordingly, the concatenation of each record indicum with the section and page indicia printed on the same markable surface creates a unique identifier and locator for every informational record in the assembly of informational items.

Independent Claim 1 of the present application provides a system for identifying a preprinted form and interacting therewith. As recited, the system includes a pen enabled computing device, a preprinted form and a computer program product. The preprinted form includes a page with a writing surface, a visual form identifier and a plurality of fields. The form identifier is disposed on the writing surface and is adapted to identify the nature of the page to the user, and the fields are defined by the writing surface. The computer program product is executable within the pen enabled computing device to determine the disposition of the writing stylus adjacent to the writing surface in order to actuate the pen enabled computing device. The computer program product is also executable to detect, capture, and store data input into the fields according to the nature of the page, where the nature of the page includes a function and a specific identity. Accordingly, the computer program product is further executable to identify the nature of the page to the pen enabled computing device based upon the data input into a plurality of the fields defined by the writing surface.

In contrast to the claimed invention of independent Claim 1, neither the Leichner patent nor the Gusack patent, taken individually or in combination, teach or suggest identifying the nature of a page based upon a data input into a plurality of fields defined by a writing surface of the page. The first Official Action concedes that the Leichner patent does not teach or suggest this feature, and appears to conceded that the Gusack patent likewise does not teach or suggest this feature. Nonetheless, the first Official Action alleges that the Gusack patent discloses a page

Appl. No.: 09/540,469  
Ans.dt. dated 05/25/2005  
Reply to Official Action of February 25, 2005

including a plurality of fields that identify the nature of the page. Thus, the first Official Action alleges that it would have been obvious to use a page having identifying fields disclosed by the Gusack patent, in the Leichner system since Gusack's indexing system "provides a highly organized record structure that allows for any degree of integration of paper-based systems with electronic-based informational assemblies." In contrast to these allegations of the first Official Action, Applicant respectfully submits that the Leichner and Gusack patents cannot properly be combined to teach or suggest the claimed invention even if those patents could be combined.

Presume for the sake of argument (although expressly not admitted) that the Leichner patent discloses a pen-enabled computing device and a computer program product in cooperation with the pen-enabled computing device, as recited by independent Claim 1. Also presume (again expressly not admitted) that the Gusack patent discloses form pages having fields that identify the nature of the pages, as recited by independent Claim 1, where the pages are indexed in accordance with the disclosed indexing scheme. Even in such an instance, the combination of the Leichner and Gusack patents only teach a system whereby the pages upon which a stylus of the pen-enabled computing device writes comprise form pages indexed in accordance with the Gusack system. The pen-enabled computing device of the combined system still identify the nature of the pages based upon barcodes printed thereon, instead of based upon data input into the fields of the page, as in the claimed invention. Thus, not only do the Leichner and Gusack patents not individually teach or suggest the claimed invention of independent Claim 1, the combination of the Leichner and Gusack patents likewise does not teach or suggest the claimed invention of independent Claim 1.

Applicant notes that the first Official Action appears to be suggesting that it would be obvious to modify the Leichner system to not only operate with pages indexed according to the scheme disclosed by the Gusack patent, but to further operate to determine the nature of such pages based upon fields of the respective pages. Applicant respectfully submits, however, that nothing in either the Leichner patent or the Gusack patent would support such a modification to the Leichner system. In this regard, only the Leichner patent discloses any means for determining the nature of a page, the disclosed means being a barcode encoding a page identifier. In fact, the system disclosed by the Leichner patent specifically provides a double-ended stylus

Appl. No.: 09/540,469  
Amdt. dated 05/25/2005  
Reply to Official Action of February 25, 2005

including a writing tip and a bar code scanning mechanism, as well as software for detecting whether input received from the stylus is writing data or bar code data.

Moreover, even if it could be suggested that the Gusack patent taught identifying the nature of a page based upon data input into fields of the page, Applicants respectfully submit that modifying the Leichner system to similarly identify the nature of a page would require a significant alteration of the Leichner system in a manner that changes the principle of operation of the system. And as stated in MPEP § 2143.01, “[a] proposed modification cannot change the principle of operation of a reference.” In this regard, the Leichner patent explains that although digitizers and scanners have gained importance in the fields of form processing and inventory tracking, conventional systems employ separate digitizers and scanners that must be separately handheld. To overcome this drawback, the Leichner system provides, as indicated above, a double-ended stylus including a writing tip and a bar code scanning mechanism. As explained in the Abstract section of the Leichner patent, by providing such a double-ended stylus, the Leichner system “permits a user to scan bar codes without having to replace the stylus or obtain a scanning implement.” Modifying the system with teachings necessarily resulting in eliminating the need of a bar code scanner to scan a form identifier, then, would eliminate the primary purpose of the Leichner system to provide a dual purpose stylus and method for detecting the particular input of the stylus (writing data or bar code data).

Applicant therefore respectfully submits that the claimed invention of independent Claim 1, and by dependency Claims 2-21, is patentably distinct from the Leichner and Gusack patents, taken individually or in combination. Applicant also respectfully submits that independent Claims 22, 43 and 50 each recite subject matter similar to that of independent Claim 1. In this regard, independent Claims 22, 43 and 50 each recite receiving data input into fields of a page, and determining the nature of the page based upon the data input, or otherwise as data is input into the fields, or from the fields into which data is received. Applicant therefore respectfully submits that independent Claims 22, 43 and 50, and by dependency Claims 23-42, 44-49 and 51-71, is also patentably distinct from the Leichner and Gusack patents, taken individually or in combination, for at least the same reasons given above with respect to independent Claim 1.

Appl. No.: 09/540,469  
Amdt. dated 05/25/2005  
Reply to Official Action of February 25, 2005

Thus, Applicant respectfully submits that the rejection of Claims 1-71 as being unpatentable over the Leichner patent in view of the Gusack patent is overcome.

Appl. No.: 09/540,469  
Amdt. dated 05/25/2005  
Reply to Official Action of February 25, 2005

### CONCLUSION

In view of the amendments to the claims and the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

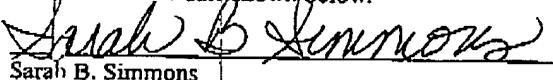


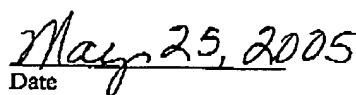
Andrew T. Spence  
Registration No. 45,699

Customer No. 00326  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111

### CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.

  
Sarah B. Simmons

  
Date

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**